

Appln No.: 10/604,166
Amendment Dated: May 2, 2006
Reply to Office Action of January 4, 2006

REMARKS/ARGUMENTS

This is in response to the Office Action mailed January 4, 2006 for the above-captioned application. Reconsideration and further examination are respectfully requested.

It is noted that the Examiner refused in a telephone interview withdraw the finality of the previous rejection, or to allow entry of the proposed claims. Applicants have therefore filed this RCE application, and have added new claims 26-29 which recite specific catalysts and quenchers.

In the Advisory Action mailed April 24, 2006, the Examiner maintained the rejection of claims 1-25 under 35 USC § 103 as obvious over Rosenquist in view of Sakshita and Mestanza. Applicants traverse this rejection.

In the Advisory Action, the Examiner states that the recited polymerization process "has little probative value" because the claims are composition claims. It is not at all clear to which argument in the prior paper this statement is responding. Applicants did point out that claim 1 requires the polycarbonate to have been made with an acidic catalyst and basic quencher, and that claim 2 requires the catalyst to be a sodium salt. The point of this argument, however, was to make it clear to the Examiner that he must look at claims 1 and 2 individually and make separate assessments as to whether the results were commensurate in scope with the claims.

In maintaining the position that the evidence is not commensurate in scope with the claims, the Examiner has chosen to ignore the teachings of the specification, and how they would be understood by persons skilled in the art. More importantly, however, he has treated the scope of the claims as if the language "wherein components (a) and (b) work in combination such that the composition achieves a V0 UL flammability rating at a thickness of 2 mm and has a haze of no more than 1%" were not present. This is improper. The Examiner may not pick and choose the provisions of the claim that are convenient for maintaining the rejection. He must look at the claims as a whole.

The Examiner compares the numerical ranges in the claims to those in the Examples, and argues that the results are not commensurate because the numbers are not identical. The Examiner goes so far as to argue that 24.2 is not commensurate in scope with the end points of 25 and 24 recited in claims 24 and 25 respectively. The purpose of requiring data that is commensurate is not to see how many experiments the Examiner can force an applicant to perform, but rather to ensure that the effect that is demonstrated and relied upon to reach a conclusion of non-obviousness is reasonably expected to be observed across the breadth of the claim. The Examiner has not even attempted to explain why such a conclusion would not be reached.

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With respect to claim 2, the Examiner implies that the recitation of the sodium salt would be sufficient with respect to defining the catalyst, does asserts that it is not sufficiently limited because the acid is not defined. As previously noted, however, Applicants have tested two different acidic quenchers that have absolutely nothing in common except the fact that they are acidic. Specifically, it is noted that the Examples make use of two very different acid quenchers. Phosphorous acid is a Bronsted acid because it can act as a proton donor. The tosylate on the other hand is a Lewis acid, which can donate an electron pair, but which has no proton to donate. In these circumstances, there is no apparent basis for an assertion that these two species are not representative of the class of acid quenchers as claimed, and thus no basis for the continued rejection of claim 2.

Furthermore, it is noted that original claims 6-9 and 12-15 specifically recite both a sodium salt (because they are dependent on claim 2) and specific acidic quenchers. Original claims 20-23 specifically recite that the catalyst is sodium hydroxide and specific acid quencher. The Examiner's arguments are therefore inconsistent with the statement of rejected claims.

The examiner also rejected claims 1-25 as obvious over Mark et al in view of Rosenquist, Nouvertne, Sakashita and Mestanza. The Examiner relies on mark for the same teaching as he relies on Rosenquist, except that he then has to take an element from Rosenquist as well in structuring the rejection. This rejection therefore is cumulative with the rejection discussed above, and should be withdrawn for the same reasons.

In view of the foregoing, Applicants submit that this application is now in form for allowance. Should the Examiner maintain the rejection as to some or all of the claims, however, Applicants respectfully request some **scientific reasons** for the statement that the evidence is not commensurate in scope so that meaningful tests can be performed or so that the basis for the argument can be challenged.

Respectfully submitted,



Marina T. Larson, Ph.D
Attorney/Agent for Applicant(s)
Reg. No. 32038

(970) 262-1800